

REMARKS

Claims 1-27 remain in the application. Applicants respectfully request reconsideration of this application in view of these remarks.

Double Patenting

Claims 1-11 and 14-16 are rejected for double patenting. Applicant submits herewith the terminal disclaimer that fully complies with 37 CFR 3.73(b) and therefore the double patenting rejection no longer applies.

Claim Rejections - 35 U.S.C. § 102(b)

Claims 19-27 are rejected under 35 USC 102(b) as being anticipated by USPN 5,548,631 (Krebs).

MPEP § 2131 provides:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F. 2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim

Regarding Claim 19, the Examiner asserts that "Krebs discloses a method comprising the step of: receiving, from a communication unit participating in an audio call with at least one other communication unit (communication unit 1 initiates a dispatch call request, column 7, lines 67)" Office Action, February 7, 2005, page 4. It is noted that the Examiner's reliance upon Krebs appears to be misplaced.

Contrary to the Examiner's position that all elements of Claim 19 are found in the Krebs reference, the step of "receiving, from a communication unit, *participating in an audio call* with at least one other communication unit, a request for data from a server" is not, so the rejection is unsupported by the art and should be withdrawn. Described in col. 7 lines 67 is an example of a dispatch call set-up sequence where the communication unit initiates a dispatch call on a control

channel. In Krebs, the communication unit is able to support both cellular telephone services and trunked dispatch services by sharing some of the system infrastructure. Krebs, Abstract. However, there is no mention of the communication unit "participating in an audio call" while "receiving ... a request for data from a server" as in the claimed invention. In Krebs, the communication unit is setting up a dispatch call on a control channel not "participating in an audio call" while "receiving ... a request for data from a server." Applicants' claims require the step of "receiving, from a communication unit, *participating in an audio call* with at least one other communication unit, a request for data from a server." Because this step is missing from the Krebs reference, a rejection under 35 U.S.C. § 102(e) is improper and should be withdrawn.

Claim Rejections - 35 U.S.C. § 103(a)

Claim 23 is rejected under 35 USC 103(a) as being unpatentable over Krebs.

MPEP § 2141.03 requires:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Regarding Claim 23 as mentioned above with respect to the independent Claim 19, the step of "receiving, from a communication unit, *participating in an audio call* with at least one other communication unit, a request for data from a server" are not taught or suggested by the Krebs reference, so the rejection of the dependent claim depending from independent Claim 19 is unsupported by the art and should be withdrawn. Therefore a rejection under 35 U.S.C. 103 is unsupported by the art and should be withdrawn.

Allowable Subject Matter

Applicant thanks the Examiner for the allowance of Claims 17-18 and looks forward to the allowance of the remaining claims.


No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Please charge any fees associated herewith, including Terminal Disclaimer Fees, to Deposit Account No. 502117.

Respectfully submitted,

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